

REMARKS

Claims 1, 2, 4-6, 8-10, 12-14, 16-18, 20, 22, 23, 25-30 and 33 are pending in this application. Claims 1, 2, 4, 5, 13, 20, 22, 23 and 33 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. The Applicant appreciates the Examiner's indication of allowability concerning claims 2, 5-6, 13-14 and 23.

I. Election/Restrictions

The examiner contends that there is a serious burden for searching/considering both groups since considering the subcombination in group II with separate utilities such as "searching for a subscriber database of the private mobile communication system to determine whether the mobile communication terminal is registered or not and performing a location registration of the mobile communication terminal according to registration result" requires further search in subclass 435.2 in addition to subclass 426.1 which is required for group I.

First, the restriction requirement cannot be made final as it is the first time that the Examiner is mentioning the subclasses of the groups. However, the Examiner has failed to provide the class of the groups and therefore, it is difficult to respond to the restriction requirement. Therefore, not only for the reasons mentioned in the response to the restriction requirement, the Examiner has failed to provide the proper class for groupings and therefore, further consideration is necessary for the restriction requirement to allow for a proper response by the Applicant.

II. CLAIM REJECTIONS - 35 U.S.C. § 102

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

A. Claims 1, 4, 12, 20, 22, 25-26, 28, 30, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (US 2002/0022497). The Applicant respectfully traverses.

1. Regarding claims 1, 4, 12, 20, 22, 33, the Examiner states that Kim et al. teaches a method for providing a user with a private mobile communication service when a mobile communication terminal enters a private mobile communication network being interoperable with a public mobile communication network (see figure 2 and paragraphs [0048], [0049]), comprising the steps of: upon receiving a system parameter message being broadcast by the private mobile

communication system, checking a predetermined bit for indicating the private mobile communication service area contained in the system parameter message; when the mobile communication terminal exists in the private mobile communication service area, transmitting a location registration message (e.g., call origination request message generated by the mobile station 44 in the public/private mobile communication network 40 is provided to the call manager 80 - see paragraph [0053]) including a predetermined registration type (e.g., public or private mobile communication request - see [0053]) to the private mobile communication system.

However, as seen in paragraph 0039 of Kim et al., the call manager 80 determines from the call origination request message of the mobile station of whether the service is public or private. In the present invention, however, a system parameter message is broadcast from the private network and it is checked for the predetermined bit by the mobile station, and if the predetermined bit is set up, transmitting a location registration message.

2. The Examiner further states that Kim et al. includes receiving a message including a private mobile communication service associated command from the private mobile communication system according to registration result information of the private mobile communication system (e.g., sends a specific message to the private mobile system 22 - [0054]; and performing a command contained in the received message (see [0055]).

However, as seen in paragraphs 53-55 of Kim et al., if the call manager 80 determines that the call origination request message is equivalent to the private request message, then the call

manager sends the request to the internal BSC for call processing and then sends a specific message to the private system and a call control is performed.

Therefore, Kim et al. mentions the receiving of the message including the private service associated command, but in Kim it is performed by the call manager. In the present invention, it is the mobile station that receives the message and performs the command.

3. The Examiner states that regarding claims 25-26, 28, 30, Kim et al. teaches the method as set forth in claim 1, wherein the command allows the mobile communication terminal to perform a manner mode conversion function (e.g., frequency conversion, frequency down conversion to baseband - see [0054]).

However, looking at paragraph 54, the mobile communication terminal is not indicated as performing a manner mode conversion function. The terminal is not even mentioned in paragraph 54. The internal BSC and MSC modules receive the call origination request message and there is a determination of the radio channel of the transcoder and selector bank. Looking at the remaining portions of the disclosure, there is no mentioned of manner mode conversion including for example frequency conversion, frequency conversion to baseband.

4. Moreover, the present invention is not anticipated by Kim et al., because of the difference of the operation subject and a difference in providing service.

The difference of the operation subject between Kim et al. and the present invention is as follows. As mentioned above, even if Kim et al. discloses a call manager to transmit a message to

the corresponding network after analyzing the message from the mobile communication terminal, however, in the present invention, a system parameter message is broadcast from the private network and it is checked for the predetermined bit by the mobile station, and if the predetermined bit is set up, transmitting a location registration message.

The difference of providing a service between Kim et al. and the present invention is as follows. When the MS enters a specific area (the private communication network area), the MS receives a message provided by the private communication network, and performs a command contained in the message.

Additionally, the object of the present invention is performing a service provided by the private network, not informing whether the private communication service is possible or not, when the MS enters a specific area (the private communication network area).

On the other hand, Kim et al. discloses a system for distinguishing the public service from the private service, in the case of simultaneously supporting the private network service and the public network service in the specific private network, in which the message contains the information to distinguish whether it is for the private communication network or the public communication network.

Therefore, the present invention includes a technique to confirm whether or not a service is provided when a private network is registered, while Kim et al. is an invention to provide a service by distinguishing the private communication network and public communication network service when providing an actual service after registration. Therefore, since according to MPEP §2131,

every element is not literally present, arranged as in the claim, expressly or inherently, the Kim et al. does not anticipate the present invention.

III. ALLOWABLE SUBJECT MATTER

The examiner stated that claims 2, 5-6, 13-14, and 23 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Following the advice of the examiner, claims 2, 5, 13 and 23 were rewritten in independent form including all of the limitation of the base claim and any intervening claims. Therefore, claims 2, 5-6, 13-14, and 23 should be allowable.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$200.00 is incurred by this Amendment for the addition of one (1) independent claim above eleven (11). Applicant's check drawn to the order of the Commissioner accompanies this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned

attorney in the amount of such fees.

Respectfully submitted,



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